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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/800,592 | 03/06/2001 | Robert Olan Keith JR. | ABREAU-00103 | 2681 |
| 28960 | 7590 | 12/28/2005 | | |
| HAVERSTOCK & OWENS LLP 162 NORTH WOLFE ROAD SUNNYVALE, CA 94086 | | | EXAMINER NGUYEN, CAM LINH T | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2161 | |
| DATE MAILED: 12/28/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/800,592

Applicant(s)

KEITH, ROBERT OLAN

Examiner

CamLinh Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. In view of Appeal Brief filed on 10/11/2005, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. Applicant's amendments to claims 1 – 37 are acknowledged. Claims 1 – 37 are pending.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1 – 37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 2, 4- 13, 15 – 24, 26 – 26, 38 – 45 of copending Application 09/800,607; claims 1, 4 – 15, 17 – 25, 28 – 39, 41 – 49, 52 – 63, 65 – 73, 76 – 87, 89 - 96 of copending Application No. 09/801,138; claims 1 - 49 of copending Application No. 09/801,072; claims 1 – 4, 6 – 15, 18 – 27, 30 – 39, 42 – 51 of copending Application No. 09/801,076; claims 1 – 7, 9 – 15, 17 – 23, 25 – 29, and 31 – 32 of copending Application No. 09/800,566; claims 1, 3 – 12, 14 – 23, 25 – 34, 36 – 42 of copending Application No. 09/799,032; Claims 1, 4 – 11, 14 – 21, 24 – 31, and 34 – 38 of copending Application No. 09/801,140.

Claims Comparison Table

| '592 | '076 | '138 | '072 | '140 |
|--------|------|------|------|------|
| Claims | | | | |
| 1 | 1 | 1 | 1 | 1 |
| '592 | '032 | '607 | '566 | |
| Claims | | | | |
| 1 | 1 | 1 | 1 | |

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Most limitations in instant application can be found on copending ' 056, '592, '032, '072, '138, '076, '140. For instance:

A search module includes a keyword search, a hierarchical search, a dichotomous key search, and a parametric search and "formatting a searchable database", "accessing a node", " or utilizing a search module" can be found in other applications are found in the instant applicant and in other applications.

Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been prima facie obvious to one with ordinary skill in the art at the time the invention was made to broaden the invention because this provides a wider application of the invention with no additional cost in development.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 11, 20, 30, and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

When regarding in light of Fig. 1, the claim language "utilizing a search module" in limitation (a) should be "utilizing a research module" since the invention, especially in Fig. 1, describes five modules; namely Keyword search module, Parametric search module, Dichotomous key module,

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Hierarchical tree module. It is not clear which search module that is being referred to in claim 1.

Therefore, renders the claim vague and indefinite.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 – 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wesinger Jr. et al (U.S. 5,778,367) in view of Anthony Stuart (U.S. 5,613,110).

♦ As per claims 1, 11, 20, 30, 37

Wesinger discloses a method of performing a research task within a searchable database comprising:

- “Performing a search by utilizing a search module, the search module includes a keyword search, hierarchical search, a dichotomous key search, and a parametric search ... matching items” See Fig. 2H. In fig. 2H, Wesinger also allows the users multiple search methods, including:
 - Keyword search
 - Hierarchical search corresponds to categories search.
 - Parametric search corresponds to Example search.
- “The searchable database is formatted in a directory tree structure” See col. 10, lines 61 – 62 of Wesinger.

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- “The directory tree structure includes nodes ... branches” See col. 10, lines 61 - 65. Each category corresponds to a node. All nodes are linked together.
- “ Selecting one of the matching item” See Fig. 2J, 2M and 2N where the user can select a particular matching item.
- “Formatting the collection of related data corresponding to the node of the selected matching item into an encyclopedia-like entry” See Fig. 2J, col. 10, lines 65 – col. 11, lines 4 of Wesinger.
- “ Displaying the encyclopedia-like entry corresponding to the node of the selected matching item” See Fig. 2J, 2M and 2N where the user can select a particular matching item, and the result is displayed in Fig. 2N.

The Wesinger reference fails to disclose the dichotomous key search. However, this method search is a well known in the art. Stuart provides an example of it.

Stuart teaches that a dichotomous key search is used to search for data in the database (See Abstract).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to apply the teaching of Stuart into the invention of Wesinger because Wesinger suggested that multiple search method are available for user and the combination would reduce the memory access when using binary search, and providing user more search methodologies.

◆ As per claims 2, 12, 21, 31, the combination of Wesinger and Stuart disclose:

- “ The encyclopedia-like entry includes text, graphics, links...” See Fig. 2N and 2O.

◆ As per claims 3, 13, 22, 32, the combination of Wesinger and Stuart disclose:

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- “The search criteria is one or more keywords input by a user” See Fig. 2H, 2L of Wesinger.
- ◆ As per claims 4, 14, 23, 33, the combination of Wesinger and Stuart disclose:
 - “The utilized search methodology is the hierarchical search, the search criteria is selected one of a list of one or more directory items” A hierarchical search” corresponds to “category search” because the categories include subcategories that organized in a hierarchical order. See Fig. 2I – 2J, col. 10, lines 61 – 62 of Wesinger.
- ◆ As per claims 5 – 6, 15 – 16, 24 – 25, 34 – 35, the combination of Wesinger and Stuart disclose:
 - “ The utilized search methodology is the dichotomous key, the search criteria is a selected one of two binary items” See abstract of Stuart.
 - “ The utilized search methodology is the parametric search, the search criteria is one or more set parameters, and further wherein the parameters are set by a user” See Fig. 2K, col. 5, lines 53 – 55 of Wesinger.
- ◆ As per claims 7, 17, 26, 36, the combination of Wesinger and Stuart disclose:
 - “The searchable database is distributed into more than one physical location” See Fig. 1A, wherein more than one databases are presented.
- ◆ As per claims 8 - 10, 18 - 19, 27 – 29, the combination of Wesinger and Stuart disclose:
 - “ The steps of performing a search and formatting the collection of related data are performed by a server” See Fig. 2K, col. 5, lines 53 – 55 of Wesinger.
 - “ Establishing an Internet connection with the server to utilize the search methodologies” See Fig. 1A- 1B of Wesinger.

Response to Arguments

9. Applicant's arguments with respect to claims 1 - 37 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CamLinh Nguyen whose telephone number is (571) 272 - 4024. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272 - 4023. The fax phone number for the organization where this application or proceeding is assigned is 571 - 273 - 8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit 2161

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